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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,934	01/08/2002	Barry J. Fiala	A0,031	4908

7590 05/13/2005

Russell H. Walker
Walker, McKenzie & Walker, P.C.
Suite 434
6363 Poplar Avenue
Memphis, TN 38119-4896

EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,934

Applicant(s)

FIALA ET AL.

Examiner

Evans Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/03/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-50 have been examined.

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The provisional patent #60/260,058 was filed 01/05/2001. Application #10/041,934 was filed on 1/08/2002, and therefore does meet the 12 month criteria for priority.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-15, 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dawson (U.S 6,270,012), in view of Agraharam et al. (U.S 5,987,508).

As per claims 1, 5-15, 21-32, Dawson discloses a computer system/method for providing security for the embedded value of debit card comprising of:

- Providing a product, bearing an identification/activation code associate with a package, bearing the product's identification code, being sold and activated at the point of sale (column 2, lines 58-67 and column 3, lines 1-6)
- The Point-Of-Sale (POS), communicating with a central computer, transmitting the an identification/activation code and associating the PIN the product (column 6, lines 27-41)
- The package obscures PIN (column 3, lines 9-10)
- Identification/activation code is in machine readable format such as magnetic stripe and bar code with their respective data terminal readers (column 6, lines 1-7)
- The data terminals are communicating via a suitable network with a remote central processing computer (column 6, lines 8-26)
- Dawson also teaches that data can be made available on a magnetic stripe, as well as on a chip or related circuitry constructed as smart cards; data can be read when such cards are presented to a reader (column 5, lines 36-41)
- Adding websites on packaging is well known in the art (see Setteducati – US 6,876,976 – Figures 1-3)

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- Providing a plurality of cards (column 5, lines 45-46)

Dawson did not explicitly describe a method/system in which the PIN, once activated, can be registered over the phone or on the web. However, Agraharam et al. describes a method/system in which products can be registered in over the web in response to an input URL (column 5, lines 44-47) and over the telephone using a PIN (column 6, lines 23-67, column 7, lines 1-7). User registers by inputting auxiliary information such as email address and telephone number (column 3, lines 39-40). The system also uses Interactive Voice Response (column 6, lines 43-45). When the user registers, a confirmation is sent to the user's account address with a confirmation number (column 6, lines 50-51). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would employ data characteristics for the insertion of watermarks. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement a system that would allow consumers to register their products. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement a system that would allow consumers to register products because it would allow cross selling of other products by sending consumers information on major upgrades and new products as soon as they are available.

5. Claims 2-4 and 33-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (U.S 6,270,012) and Agraharam et al. (U.S 5,987,508), in view of Small (U.S 5,513,117).

As per claims 2-4 and 33-44, Dawson and Agraharam et al.'s inventions have previously been disclosed.

Dawson and Agraharam et al. did not explicitly describe a method/system in which data on a surface can be covered by materials that can be peeled off or scratched off. Dawson and Agraharam et al. did not also explicitly describe a method/system in which products are being sold via a kiosk. However, Small describes a method and apparatus for simultaneously dispensing personalized greeting cards and electronically vendable gifts (column 2, lines 30-32). The kiosk includes a printer (column 2, line 36). Once the transaction is confirmed, PIN numbers and instructions can be printed on a portion of the card (column 2, lines 48-49). An opaque, peelable or scratch off substance may cover the PIN number (column 6, lines 1-5). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that employs a kiosk for vending or dispensing products because it provides a convenient way for customers to buy products (column 2, line 8). Kiosks can provide a powerful competitive advantage by minimizing labor costs, shortening wait-time and strengthening customer loyalty. Additionally, It would have also been obvious for one of ordinary skill in the art at the time of the applicant's invention to use an opaque peelable or scratch off substance to cover the PIN number because it would deter theft, as users would know if their product has been tampered with.

6. Claims 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small (U.S. 5,513,117), in view of Schultz (U.S. 20010045742).

As per claims 45-50, Small's invention has previously been disclosed.

Small did not explicitly describe a method/system in which data is printed on top of an opaque covering substance. However, Schulz describes a method in which data information can be printed on top of a scratch off surface (column 1, paragraph 15). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to print data on top on an opaque substance covering data because such method would further reduce the counterfeiting of the product (column 1, paragraph 3).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kure (US 6224108)
- Fiala et al. (US 6270012)
- Freeman et al. (US 6019284)
- Pearce et al. (US. 6243468)
- Zimmers et al. (US 6816878)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents

Application/Control Number: 10/041,934

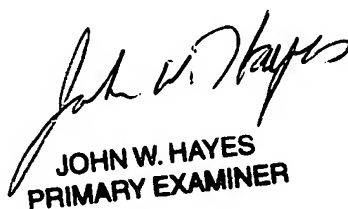
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P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
May 2, 2005
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JOHN W. HAYES
PRIMARY EXAMINER